UNITED STATES PATENT AND TRADEMARK OFFICE

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09/667,779	09/22/2000	Nicolas Brogne	Q60742	1269

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Sughrue Mion Zinn MacPeak & Seas PLLC
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER
DINH, KHANH Q

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO 90C (Rev 10/03)

<table>
<tr>
<td rowspan="2">Office Action Summary</td>
<td>Application No.
09/667,779</td>
<td>Applicant(s)
BROGNE ET AL.+</td>
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<td>Examiner
Khanh Dinh</td>
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2151</td>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*25 October 2004*</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

☐ closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
        application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This is in response to the Amendment filed on 10/25/2004. Claims 1-12 are

presented for examination.

Correction

2.   There is a typo error in the last Office Action as Uchida et al. (hereafter Uchida)

listed as U.S. pat. No.*6,237,610*. The Uchida reference patent number is corrected as

Uchida et al. (hereafter Uchida), U.S. pat. No.**6,327,610** throughout the Office Action.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent
by another filed in the United States before the invention thereof by the applicant
for patent, or on an international application by another who has fulfilled the
requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before
the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1, 2, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated

by Nielsen (hereafter Nielsen), U.S. pat. No.5,870,548.

As to claim 1, Nielsen discloses a method of manipulating (modifying) a sent e-mail,

addressed by a sender to a plurality of addressees (recipients), said sent email

comprising an address header and a body (see fig.6B), wherein said method

comprising:

        routing a modification message (sending an action message to alter a previously

sent message) over a data network (sending a message over Internet, see col.6 lines

17-43) to a server (sender's email system 200 fig.2), that operates independently from

any e-mail processing means (sender email programs) associated with each of said

addressees (recipients) [enabling sender at the Email Control System to modify

message or delete a message after the message left the Email Control System (200

fig.2) to the remote Recipient Email System 202 fig.2 regardless of the sender email

programs, see col.6 lines 44-67] and on which at least the body of said sent e-mall is

stored, said modification message (409 fig.4) being sent by said sender (sender 407

fig.4) for modifying (altering) said e-mail body (using the senders programs to alter or to

modify a previously sent messages located at the Email Receiver, see abstract, figs.2,

4, col.7 line 2-65).

        modifying said e-mail body (allowing a sender to modify a previously sent email

message) at said server (sender's email system 200 fig.2) according to said

modification message (if sender select to modify the message, taking the sender to the

modification path, see col.8 line 4 to col.9 line 22), if said e-mail body has not been

accessed (inactive) on said server by any of said addressees (checking to see if the

messages have been viewed by recipient, see fig.8B, col.12 lines 5-38), wherein the

modification of said email body occurs at said server (sender's email system)

independently of any email processing means associated with each of said addressees

(recipients) [enabling sender to modify message or delete a message after the message

left the Email Control System (200 fig.2) to the remote Email Receiver 202 fig.2

regardless of the sender email programs, see col.6 lines 44-67 and col.18 lines 1-29]

As to claim 2, Nielsen discloses modification of said email consists in deleting said e-

mail body or modifying a part of said e-mail body (modifying or delete a email

message), said sender being informed by said server if said modification has been

executed or not (using a modify database to track previously sent messages have been

modified, see fig.8C, col.12 lines 39-64).

As to claim 11, Nielsen discloses a computer program product to be executed on a

computer comprising computer program code embodied on a computer-readable

medium, said computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify

field including request for modifying a email message, see fig.11A, col.15 lines 41-51)

for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and

sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of
the email sent to (modifying or deleting email message including the body) and stored
on said predefined server if the email body has not been accessed on said server by
any of addressee (modifying the previous sent email message if the message has not
been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said
email body occurs at said server (sender's email system) independently of any email
processing means associated with each of said addressees (recipients) [enabling
sender to modify message or delete a message after the message left the Email Control
System to the remote Email Receiver regardless of the sender email programs, see
col.6 lines 44-67 and col.18 lines 1-29].

As to claim 12, Nielsen discloses a personal computer equipped with a computer
program according to claim 11, computer program to be executed on a computer
comprising computer program code embodied on a computer-readable medium, said
computer program code means adapted to perform following steps:

composing a modification message (receiving a message containing a X-modify
field including request for modifying a email message, see fig.11A, col.15 lines 41-51)
for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and
sent to a predefined server (200 fig.2) (see col.15 line 52 to col.16 line 25).

sending said modification message to said server to modify at least the body of
the email sent to (modifying or deleting email message including the body) and stored
on said predefined server if the email body has not been accessed on said server by

any of addressee (modifying the previous sent email message if the message has not

been seen, see fig.11B, col.16 line 61 to col.17 line 22), wherein the modification of said

email body occurs at said server (sender's email system) independently of any email

processing means associated with each of said addressees (recipients) [enabling

sender to modify message or delete a message after the message left the Email Control

System to the remote Email Receiver regardless of the sender email programs, see

col.6 lines 44-67 and col.18 lines 1-29].

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

7.   Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nielsen in view of Uchida et al. (hereafter Uchida), U.S. pat. No.**6,327,610.**

As to claim 3, Nielsen discloses a server (email system 200 fig.2) to be part of an e-mail

system, said server being able to receive, from a data network (Internet 200 fig.2), an e-

mail comprising an address header and a body by a sender (sender) to a plurality of

addressees (recipients), said server comprising:

storing the body of a received e-mail (email system receiving a email message

containing X-modify, see col.15 lines 45-52) together with an authentication protection

(authentication protection including in the header of an email message, see col.10 lines

21-51) on said server (Email Control System 200 fig.2).

sending to each addressee (recipient) of said e-mail a notification (confirmation

message) containing the access code for accessing said e-mail body (using database

1104 fig.11A to check for a matching entry, see fig.11A, col.15 line 51 to col.16 line 5)

handling a status storage (database 1105 fig.11A) indicating at least whether

said e-mail body has been accessed by one of said addressees (maintaining

information in the database if the recipient has seen the message, see col.16 lines 6-

25).

if a modification message for modifying said e-mail body is received, modifying

said e-mail body according to said modification message (modifying or deleting

message), if said e-mail body has not been accessed on said server by any of said

addressees [modifying the previous sent email message if the message has not been

seen, see fig.11B, col.14 lines 22-64 and col.16 line 61 to col.17 line 22], wherein the

modification of said email body occurs at said server (sender's email system)

independently of any email processing means associated with each of said addressees

(recipients) [enabling sender to modify message or delete a message after the message

left the Email Control System to the remote Email Receiver regardless of the sender

email programs, see col.6 lines 44-67]

Nielsen suggests using an authentication protection to protect the access to email

messages (using authentication protection facility in the headers of email message).

Nielsen does not specifically disclose an access code. However, Uchida in the same

broadcasting electronic mails in the Internet discloses an access code, storing an

access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54

to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the

time the invention wad made to implement an access code in the computer system of

Nielsen to protect the privacy of email messages because it would have enabled

prevention of enormous traffic at a network caused by distribution of electronic mail

(see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email

distribution in a communications network.

As to claim 4, Nielsen discloses sending a message to the sender of said modification

message to notify the sender if the modification has been executed or not (using a

modify database to track if previously sent messages have been modified, see fig.8C,

col.12 lines 39-64 and col.14 lines 45-64).

As to claim 5, Nielsen disclose sending a message to the sender of said e-mail containing authentication information associated to said e-mail (sender storing a modify message including authentication header for providing a previous sent email message, see figs.2, 7B, col.10 lines 21-51). Nielsen suggests using an authentication protection to protect the access to email messages (using authentication protection facility in the headers of email message). Nielsen does not specifically disclose an access code. However, Uchida in the same broadcasting electronic mails in the Internet discloses an access code, storing an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at the time the invention wad made to implement an access code in the computer system of Nielsen to protect the privacy of email messages because it would have enabled prevention of enormous traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email distribution in a communications network.

As to claim 6, Nielsen discloses downloading said e-mail body to one of said addressee (recipient) providing an authentication and deleting said e-mail body at said server when each one of said addressees has accessed said e-mail body at said server (email system) (modify or deleting a message according to how long the messages have been inactive and checking to see if the messages have been viewed by recipient, see col.12 line 39 to col.13 line 6). Nielsen suggests using an authentication protection to protect

the access to email messages (using authentication protection facility in the headers of

email message). Nielsen does not specifically disclose an access code. However,

Uchida in the same broadcasting electronic mails in the Internet discloses an access

code, storing an access code as a key for access to the electronic mail, see Uchida's

fig.2, col.6 line 54 to col.7 line 24). It would have been obvious to one of the ordinary

skill in the art at the time the invention wad made to implement an access code in the

computer system of Nielsen to protect the privacy of email messages because it would

have enabled prevention of enormous traffic at a network caused by distribution of

electronic mail (see Uchida's col.3 lines 9-22) and thus protected the privacy of

electronic email distribution in a communications network.

As to claim 7, Nielsen discloses storing the header of said e-mail and executing an

authentication procedure (using an authentication header information in the modify

message) when a user tries to access said e-mail body (see figs.2, 6A-6D, 7A, col.7 line

40 to col.8 line 59, col.9 lines 22-67 and col.10 line 21 to col.11 line 43). Nielsen

suggests using an authentication protection to protect the access to email messages

(using authentication protection facility in the headers of email message). Nielsen does

not specifically disclose an access code. However, Uchida in the same broadcasting

electronic mails in the Internet discloses an access code, storing an access code as a

key for access to the electronic mail, see Uchida's fig.2, col.6 line 54 to col.7 line 24). It

would have been obvious to one of the ordinary skill in the art at the time the invention

wad made to implement an access code in the computer system of Nielsen to protect

the privacy of email messages because it would have enabled prevention of enormous

traffic at a network caused by distribution of electronic mail (see Uchida's col.3 lines 9-

22) and thus protected the privacy of electronic email distribution in a communications

network.

As to claim 8, Nielsen discloses storing the header of said e-mail and receiving a

modification message (generating required headers after receiving an action message,

see col.9 lines 23-42), dedicated to modifying said e-mail header only OR said e-mail

body (modifying said email body) and modifying said e-mail header according to said

modification message (modifying or cancel message in the e-mail's header, see figs.7A,

col.9 lines 23-67), if said e-mail has not been accessed by any of said addressees (if

the message is not viewed by recipient by using a message seen field, see fig.8B,

col.10 lines 21-48 and col.12 lines 5-38).

As to claim 9, Nielsen discloses storing the header of said e-mail and sending to said

addressees an e-mail containing said e-mail header and said e-mail body after a

predefined time period (a week) (deleting email message if it has been inactive for more

than a week) and deleting (deleting message) at said server said e-mail header and

said e-mail body (see fig.8C, col.12 line 39 to col.13 line 23).

As to claim 10, Nielsen discloses a computer program product to be executed on a

server according to claim 3, said computer program product comprising means

embodied on a computer-readable medium and adapted to perform a method of

modifying an email comprising an address header (header field of the message) and a

body and sent to a plurality of addressees (recipients), said method comprising:

storing the body of a received e-mail (email system receiving a email message

containing X-modify, see col.15 lines 45-52) together with an authentication protection

(authentication protection including in the header of an email message, see col.10 lines

21-51) on said server (Email Control System 200 fig.2) and sending to each addressee

(recipient) of said e-mail a notification (confirmation message) containing the access

code for accessing said e-mail body (using database 1104 fig.11A to check for a

matching entry, see fig.11A, col.15 line 51 to col.16 line 5), handling a status storage

(database 1105 fig.11A) indicating at least whether said e-mail body has been accessed

by one of said addressees (maintaining information in the database if the recipient has

seen the message, see col.14 lines 22-64 and col.16 lines 6-25) and if a modification

message for modifying said e-mail body is received, modifying said e-mail body

according to said modification message (modifying or deleting email message including

the body), if said e-mail body has not been accessed on said server by any of said

addressees [modifying the previous sent email message if the message has not been

seen, see fig.11B, col.16 line 61 to col.17 line 22], wherein the modification of said email

body occurs at said server (sender's email system) independently of any email

processing means associated with each of said addressees (recipients) [enabling

sender to modify message or delete a message after the message left the Email Control

System to the remote Email Receiver regardless of the sender email programs, see

col.6 lines 44-67 and col.18 lines 1-29].

Nielsen suggests using an authentication protection to protect the access to

email messages (using authentication protection facility in the headers of email

message). Nielsen does not specifically disclose an access code. However, Uchida in

the same broadcasting electronic mails in the Internet discloses an access code, storing

an access code as a key for access to the electronic mail, see Uchida's fig.2, col.6 line

54 to col.7 line 24). It would have been obvious to one of the ordinary skill in the art at

the time the invention wad made to implement an access code in the computer system

of Nielsen to protect the privacy of email messages because it would have enabled

prevention of enormous traffic at a network caused by distribution of electronic mail

(see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email

distribution in a communications network.

Response to Arguments

8.   Applicant's arguments filed on 10/25/2004 have been fully considered but they

are not persuasive.

* Applicant asserts that the Neilsen reference does not disclose routing a

modification message for modifying a body of sent email to a server where the sent

email is stored and modifying the body of sent email if e-mail body has not been

accessed on said server by each addressee, wherein the modification of said email

body occurs at said server apart from any email processing means associated with each addressee.

Examiner respectfully disagrees. Examiner points out that Nielsen discloses an electronic mail system with the capability to act on previously-sent messages that have passed beyond the scope of control of the sending email system. For example, Nielsen discloses that if a modification message for modifying said e-mail body is received, modifying said e-mail body according to said modification message (modifying or deleting message), if said e-mail body has not been accessed on said server by any of said addressees [determining if the message has not been seen by users and modifying the previous sent email message, see fig.11B, col.14 lines 22-64 and col.16 line 61 to col.17 line 22], and thereby enabling sender to modify message or delete a message after the message left the Email Control System to the remote Email Receiver regardless of the sender email programs (see col.6 lines 44-67 and col.16 line 61 to col.17 line 22) as rejected above. This is equivalent to what is claimed.

      * Applicant further asserts that there is one of skill in the art would not motivate to combine the references.

In response to applicant's argument that there is no suggestion to combine the references or one of skill in the art would not motivate to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art.

See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine

the references was disclosed in the secondary reference (Uchida reference) as stated in

the last Office Action "It would have been obvious to one of the ordinary skill in the art at

the time the invention wad made to implement an access code in the computer system

of Nielsen to protect the privacy of email messages because it would have enabled

prevention of enormous traffic at a network caused by distribution of electronic mail

(see Uchida's col.3 lines 9-22) and thus protected the privacy of electronic email

distribution in a communications network".

* Applicant further asserts that the combine of the references does not disclose
the claim limitations or claimed invention.

Applicant simply asserts that "the references do not meet the claimed

limitations". This quote is the extent of explanation provided by Applicant in support of

claim 3. This response by Applicant is insufficient to satisfy the requirement of specific

argument to have the claims considered for patentability; in accordance with 37 C.F.R.

§ 1.111 Applicant must distinctly and specifically point out "how the language of the

claims patentably distinguishes them from the references". Accordingly, a prima facie

case of obviousness is maintained as set forth in the rejections above.

Therefore, the examiner asserts that cited prior art teaches or suggests the

subject matter broadly recited in independent claims 1, 3, 10 and 11. Claims 2, 4-9 and

12 are also rejected at least by virtue of their dependency on independent claims and by

other reasons set forth in the previous office action [mailed on 9/22/2004]. Accordingly,

claims 1-12 are respectfully rejected.

Conclusion

9.   Claims 1-12 are rejected.

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Khanh Dinh whose telephone number is (571) 272-
3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m.
to 5:00 P.m.

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Zarni Maung, can be reached on (703) 272-3939.   The fax phone number
for this group is (703) 872-9306.

        Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval IPAIRI system. Status information for published
applications may be obtained from either Private PMR or Public PMR. Status
information for unpublished applications is available through Private PAIR only. For
more information about the PAIR system, see http://pair-direct.uspto.gov. Should you
have questions on access to the Private PAIR system, contact the Electronic Business
Center (EBC) at 866-217-9197 (toll-free).

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER

Khanh Dinh
Patent Examiner
Art Unit 2151
2/3/2005